

REMARKS

The present reply is submitted in response to the Office Action dated May 24, 2006. In the Office Action, the Examiner rejected claims 1-14, 18-20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Conner (20050194453) in view of Roberts (U.S. Patent No. 6,025,283). In addition, claims 15-17 were rejected under 35 U.S.C. 103(a) as being upatentable over Conner, modified by Roberts, and further in view of Kaminsky (20040121257). Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Conner, modified by Roberts, and further in view of Hinata (20030202151). Claims 23-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Conner, modified by Roberts, further in view of Makishima (U.S. Patent No. 3,468,046) and Biller (20030150762). Finally, claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Conner, modified by Roberts, further in view of Hara (U.S. Patent No. 4,876,441).

35 U.S.C. § 103(a)

With respect to the rejection of independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Conner et al. in view of Roberts, Applicants respectfully submit that the claims, as amended, define the invention over Conner et al., Roberts, or any other cited reference of record, taken alone or in combination. More specifically, independent claim 1 has been amended to define “a first layer of metal selected from the group consisting of titanium and stainless steel.” Moreover, independent claim 1 further defines that “said first layer of metal comprises embossed characters.” This feature is nowhere disclosed in Conner et al., Roberts, or any other reference of record.

As the Examining Attorney acknowledges, Conner does not suggest a first metal layer comprising embossed characters. Roberts discloses a card having a precious metal layer such as

gold, silver, or platinum. The Examining Attorney asserts that titanium is considered a precious metal, and thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roberts to the metal layer of Conner.

Applicant respectfully submits that titanium and stainless steel are not a precious metals.

Moreover, teaching gold, silver, or platinum does not suggest titanium or stainless steel to one of ordinary skill in the art. Therefore, Applicants' invention is patentable over Conner et al. in view of Roberts.

The Federal Trade Commission defines "precious metals" as "gold, silver, and platinum group metals." 16 C.F.R. § 23. Precious metals are generally defined by their rarity and high economic value. Moreover Roberts teaches "precious metal...includ[ing] high value metals such as platinum, gold (at all carats) and silver." (col. 1, lines 47-48) Applicant observes that titanium or stainless steel are neither rare, nor do they have inherent economic value. Titanium is the ninth most abundant element in the Earth's crust. Although titanium is used in jewelry, it is more commonly found in a wide variety of consumer products, such as paint, toothpaste, and sunscreen, as a pigment known as titanium dioxide. Titanium and stainless steel also have a large number of industrial applications, such as airplane and automobile chassis. Due to its abundance, titanium is not commonly used as a form of currency. Gold, silver and platinum are rare and have inherent economic value, thus they may be used as currency and to hold value.

Accordingly, each metal has been assigned an ISO 4217 currency code. In contrast, neither titanium nor stainless steel has been assigned an ISO 4217 currency code. For these reasons alone Applicants believes titanium and stainless steel are not "precious metals" in the same group as gold, silver, and platinum.

In further support of patentability over Conner et al. in view of Roberts, Applicants note that titanium's and stainless steel's high strength-to-weight ratio and tensile strength further differentiates them from gold, silver, and platinum. Gold, silver, and platinum are heavy, soft and/or malleable metals. A sheet of soft, malleable metal is easily embossed. In contrast, titanium and stainless steel are relatively lightweight, hard, and exceptionally strong. Their strength and hardness make embossing difficult. Thus, by teaching an embossed gold, silver, or platinum layer, Roberts does not suggest titanium or stainless steel.

Moreover, Roberts teaches a flexible card, one that is "sufficiently elastic to allow a surprisingly high degree of deformation" and has a "considerable degree of flexibility." (col. 2, lines 4-5 and lines 17-18) A card utilizing a layer of titanium or stainless steel would neither be considerably flexible nor surprisingly deformable. To the contrary, the same properties that make titanium and stainless steel difficult to emboss also makes them difficult to bend. Thus, Roberts must be read to teach away from strong and relatively inelastic metals such as titanium and stainless steel.

Since Conner et al. and Roberts fail to teach or suggest the elements defined in amended independent claim 1, the rejection thereto has been overcome and, respectfully, should be withdrawn.

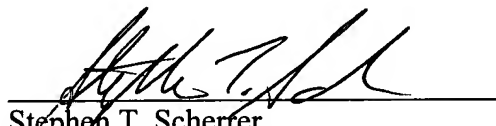
Claims 2-25 depend from independent claim 1. These claims are further believed allowable over the references of record for the same reasons set forth above with respect to their parent claims, since each sets forth additional structural elements of Applicants' novel transaction card.

CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully submit that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicants urge the Examiner to telephone Applicants' attorney so that the same may be resolved and the application expedited to issue. Applicants respectfully request the Examiner to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Stephen T. Scherfer", is written over a horizontal line.

Stephen T. Scherfer
Registration No. 45,080

227 West Monroe Street
Chicago, IL 60606-5096
Phone: 312.372.2000
Facsimile: 312.984.7700
Date: August 24, 2006

**Please recognize our Customer No. 1923
as our correspondence address.**